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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,697	09/27/2006	Gerard Marguerie	0568-1010	3522
466	7590	11/10/2009	EXAMINER	
YOUNG & THOMPSON			FINN, MEGHAN R	
209 Madison Street				
Suite 500			ART UNIT	PAPER NUMBER
Alexandria, VA 22314			1614	
			NOTIFICATION DATE	DELIVERY MODE
			11/10/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/587,697	MARGUERIE ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	MEGHAN FINN	1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 June 2009.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3,4,6,7 and 13-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3,4,6,7 and 13-18 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/30/09</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

Applicant's Amendment filed June 30, 2009 has been received and entered into present application. Claims 2, 5 and 8-12 were canceled and no claims were added by applicant. Thus claims 1, 3-4, 6-7 and 13-18 are pending.

Applicants' arguments, filed June 30, 2009, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

### ***Information Disclosure Statement***

Applicant has submitted an IDS with one reference on it which has been considered and marked appropriately. Applicant has also submitted references that were omitted with the previous IDS, however they have not provided a new IDS for those references to be considered on. The examiner also notes that some of those references are not in English and any reference that does not contain an English summary or translation will not be considered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-4, 6 and 13-18 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the elected species, CGP-02-01, does not reasonably provide enablement for the full scope of the compounds claimed. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims.

As discussed in pages 3-5 of the previous office action dated March 31, 2009, the applicant has shown how to make and use the elected compound, CGP-02-01, but has not enabled the full scope of the claims. Applicant has amended the claims to limit the scope considerably, however they still encompass a large number of distinct compounds. Applicant has only shown how to make one compound, the elected compound, and has not indicated starting materials or any direction for the other compounds encompassed by the claims. Even claim 6, which is limited to specific compounds encompasses compounds with very distinct structural differences and it would have not been obvious to one of ordinary skill in the art at the time of the invention how to make those compounds given the only direction towards the elected compound. CGP-02-02 and CGP-02-07 are particularly pointed out for being very distinct from the elected species. Applicant's arguments that the examples show the effect of various compounds is confusing because they point to example 7 in which only the elected species appears to have been tested. Furthermore, this does not address the issue of enabling one of skill in the art to make these compounds. It is noted that

this rejection is withdrawn in regards to claim 7, because that claim is limited to the elected species, which is enabled. Applicant's arguments have been very carefully considered but have not been found persuasive and the enablement rejection of claims 1, 3-4, 6, and 13-18 is maintained.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3-4, 6-7, and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cai et al. (US 2003/0105140 A1) already of record, for the reasons set forth at pages 6-7 of previous office action dated March 31, 2009, of which reasons are herein incorporated by reference.

The above claims were previously rejected over Cai et al. because Cai et al. teaches a very similar generic formula I which encompasses many of applicant's claimed compounds including the elected species. Applicant has correctly pointed out an error with the structure provided by the examiner in the previous office action, in which the benzene ring has only two methoxy groups and one hydroxyl group instead of three methoxy groups as indicated in the drawing. This was an unintentional error, however the correct structure was searched (RN 861241-91-0) and is encompassed by the teachings of Cai et al.

Applicant's arguments against the obviousness rejection are directed towards 1) that the compounds have a different function and 2) that Cai fails to provide direction to the particular elected compound CGP 02-01. With regards to argument 1, the intended use or function of a compound does not matter. The prior art is not required to have the same use or functionality as applicant has claimed to anticipate or obviate the claimed compound *per se*. The same compound has the same properties regardless of if they are recognized or not. This argument is not found persuasive.

With regards to argument 2, while Cai et al. does not provide a specific structure of the elected species as a preferred embodiment, it does not mean that they do not consider it a part of their invention. They clearly teach the same back-bone structure in formula I (page 2, [0016]) and applicant's argument that X could be something other than sulfur does not mean that Cai et al. is teaching away from or suggesting that sulfur cannot be used, in fact they clearly teach that X is O, S, or N which is only three possible atoms in that position and they are often interchanged for each other in organic

synthesis. One of ordinary skill in the art at the time of the invention would have recognized that sulfur containing compounds were well within the limits of Cai et al.'s invention. This argument is not found persuasive.

Applicant's arguments have been very carefully considered but have not been found to be persuasive and thus the rejection of claims 1, 3-4, 6-7, and 13-18 is maintained.

### ***Conclusion***

Rejection of claims 1, 3-4, 6-7, and 13-18 is deemed proper and is maintained.

No Claims of the present application are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meghan Finn whose telephone number is (571) 270-3281. The examiner can normally be reached on 8:30am-6pm Mon-Thu, 8:30am-5pm Friday (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Meghan Finn

/James D Anderson/  
Examiner, Art Unit 1614